

Linnett patent"). The Applicant respectfully traverses this arts grounds of rejection.

The Tidwell patent teaches a method and apparatus to provide wizards using a script-like language that supports a predetermined set of commands. The commands are defined by a driver called the smart guide driver. The wizards, or smart guides as they are called when implemented using the script-like means, allow the user to customize the smart guides for their particular application using a standard text editor. Thus, the smart guide driver (207) executes on top of the operating system (203) and interacts with the application program (205) to provide an interface to the application program (205). Tidwell II; col. 4, lines 10-44. The smart guide script may allow modification of the smart guide driver (207), but it fails to solicit the input prompted by Applicant's ✓ claims 1, 20, and 36.

In particular, the Tidwell patent fails to teach the prompting of "input of process steps and a plurality of potential selections associated with of the ✓ process steps," as taught by Applicant's claims 1, 20 and 36.

The Linnett patent implements a user interface for one or more application programs. The interface program interacts between the user and an application program to perform specific tasks. Linnett; col. 3, lines 5-15. The inputs from the user, which are requested by the interface program, are used to generate task commands that are sent to the application computer program to run specific tasks. The Linnett patent does not disclose any manner of building

a wizard, but instead teaches a method of using a wizard to interface between a user and an application program.

Although the Tidwell patent teaches a method for creating a wizard, and the Linnett patent teaches how an interface between a user and an application program, there is no existing motivation to combine the teachings of the Linnett patent with the Tidwell patent. There is no disclosed motivation to have the Linnett interface program as the front-end of the Tidwell wizard builder. Nor is there any disclosed motivation of attaching the Linnett interface to the front end of the Tidwell wizard builder.

In order to establish a *prima facie* case of obviousness sufficient to maintain a rejection under 35 U.S.C. § 103(a), three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings in the manner suggested. Second, there must be a reasonable expectation of success. And third, the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the

references must expressly or impliedly suggest the claimed invention or the examiner must present a *convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985).

The Applicant respectfully contends; particularly in light of the substantial differences between creating a wizard script in the Tidwell patent and the use of a wizard as a user interface in the program of the Linnett patent, there is no motivation to combine the two patents. The present action fails to provide the required "convincing line of reasoning" as to how or why one of ordinary skill would be motivated to make the proposed combination in order to solve a problem not recognized by either the Linnett patent or the Tidwell patent. Thus, the Applicant respectfully submits that neither the Tidwell nor the Linnett patent provides proper motivation for combining one with the other.

The Examiner asserts it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Linnett into the method of Tidwell:

"...to store the input processes and create the output based upon the input. The modification would be obvious because one of ordinary skill in the art would want to provide an efficient tool and allow third parties to extend and customize the features of an existing application program."

Applicants respectfully submit that the motivation relied upon by the Examiner is insufficient for one of ordinary skill in the art to combine Linnett with Tidwell. The Examiner's general assertion that third parties would want to extend and customize the features of an application program is insufficiently specific (i.e., too overly broad a conceptual statement) to direct one of ordinary skill in the art specifically toward Tidwell, over any other wizard-related teaching available at the time. The Examiner's alleged motivation is the possible outcome that would result from combining Tidwell and Linnett, not a reason why one of ordinary skill would combine Linnett and Tidwell. Using the Examiner's alleged motivation, one of ordinary skill in the art would be motivated to combine every wizard-related teaching in hopes that some improvement would be made. Applicant respectfully submits that the only hindsight would allow the combination of Linnett and Tidwell, and this is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection for this reason.

Finally, the Examiner improperly makes the assumption that the term "collecting," found in the Linnett patent, is meant to mean storing as found in claims 1, 20 and 36 of the Applicant's claims. In doing so, the Examiner states "where collecting user input relating to the specialized task is considered as storing the input process... ." However, storage means cannot be injected into the Linnett patent, where the Linnett patent does not teach or disclose storage means. It appears that claim 8, cited by the Examiner, takes the collected user

input to immediately effect the application computer program. Thus, it is improper for the Examiner to infer that a storage function is taking place; particularly when no such storage means is recited in the Linnett patent.

For at least the three reasons recited herein, the Tidwell patent in view of the Linnett patent fails to teach, recite or make obvious Applicant's claims 1, 20 and 36. The Applicant respectfully requests that claims 1, 20 and 36 be allowed.

Claims 2, 4-15, 17, 19, 21-22, 26-34, 37, 39-43

Claims 2, 4-15, 17, 19, 21-22, 26-34, 37 and 39-43 are dependent on allowable claims 1, 20 or 36, respectively. For at least their dependency on allowable claims 1, 20 or 36, and on their own merits, the Applicant respectfully requests the allowance of these claims. The Applicant traverses the arts grounds of rejection.

Claims 3, 18, 23-25, 35, 38, 44-47, 49, 58, 60 and 62

Claims 3, 18, 23-25, 35, 38, 44-47, 49, 58, 60 and 62 are rejected over the Tidwell patent in view of the Linnett patent, and further in view of Sonnenreich et al., U.S. Patent No. 5,974,446 (hereinafter "the Sonnenreich patent").

The Sonnenreich patent teaches a method of using the World Wide Web for distance learning. It includes an index of a plurality of different

informational topics, a personal information of user database, a toolbar section to choose the topics, a message reader section to integrate email, a communications chatting dialog section and the list of all the users who have selected identical or similar topics. Thus, the components of the Sonnenreich patent are integrated together to allow users in geographically separated areas to use the internet, a WAN or a LAN a single simulated classroom. The Sonnenreich patent does not teach, disclose or make obvious any method of wizard building.

Claim 44

The Examiner claims that the rejection of claim 1 with respect to the Tidwell patent and the Linnett patent are applicable to claim 44. However, the Examiner also asserts that the Sonnenreich patent discloses the propagated signal not disclosed by either the Tidwell or the Linnett patent. As detailed herein with respect to claim 1, the Tidwell patent in view of the Linnett patent, fail to disclose or make obvious claim 1. Similarly, the Tidwell patent in view of the Linnett patent, further in view of the Sonnenreich patent, fails to disclose, teach or make obvious Applicant's claim 44.

Just as the Tidwell patent in view of the Linnett patent fails to disclose "prompting input of process steps and a plurality of potential selections associated with each of the process steps," "storage of input process steps and associated potential selection," and "creation of a wizard based upon stored

process steps and associated potential selection," as taught by Applicant's claim 44; a cursory review of the Sonnenreich patent reveals that the Sonnenreich patent fails to overcome the disclosure and suggestion deficiencies of the Tidwell patent in view of the Linnett patent.

The Applicant respectfully submits, in addition to a lack of motivation to combine the teachings of the Tidwell patent with that of the Linnett patent (previously discussed), there is a lack of motivation to combine the teachings of the Sonnenreich patent. The Examiner has failed to support his conclusion of obviousness with a "convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference." *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985). The Applicant further submits that a desire for an inventor to want a bigger, better, or more "efficient" invention does not satisfy the convincing line of reasoning requirement; nor does it necessarily place such combinational teachings within the skills of the ordinary artisan.

Additionally, picking and choosing portions of references, without considering the references as a whole for what they reasonably teach, is impermissible.

In Panduit Corp. v. Dennison Manufacturing Co., 227 U.S.P.Q. 337, 344 (Fed. Cir. 1985), *vacated and remanded on other grounds*, 229 U.S.P.Q. 478 (1986) the Federal Circuit stated:

The well established rule of law is that each prior art reference must be evaluated as an entirety, and that all of the prior art must be evaluated as a whole. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 727 F.2d at 1550, 220 U.S.P.Q. at 311; *In re Kuderna*, 426 F.2d 385, 290, 165 U.S.P.Q. 575, 578-79 (CCPA 1970).

And, in Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986), the Federal Circuit stated:

As the former Court of Customs and Patent Appeals held:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (CCPA 1975).

As demonstrated above, the Federal Circuit has directed that prior art references must be considered as whole and that it is impermissible for the Examiner to pick and choose only so much of the reference as to support the Examiner's position and ignore other teachings necessary for a full appreciation of what the reference suggests.

As a whole, the Tidwell patent teaches a basic method of wizard building. The Linnett patent merely discloses the way a wizard may be used as an interface between an application program and a user. Finally, the unrelated Sonnenreich patent discloses a method of joining geographically diverse users in a single electronic classroom setting. Thus, as stated by the Federal Circuit,

it is impermissible for the Examiner to pick and choose only portions of the cited art to reconstruct the Applicant's claims, including that of claim 44.

For at least the above reasons, the Applicant submits that claim 44 is allowable. The Applicant respectfully requests that claim 44 be allowed.

Claims 45-54

Claims 45-54 are allowable for at least the reason that they depend from allowable claim 44, and on their own merits. Therefore, the Applicant respectfully requests that 45-54 be allowed.

Claims 57-62 and 65

The Applicant has shown that the Tidwell patent in view of the Linnett patent by itself, or in further view of the Sonnenreich patent fails to disclose, teach or make obvious allowable claim 1. Since claims 57-62 and 65 depend from allowable claim 1, and on their own merits, the Applicant requests allowance of claims 57-62 and 65.

Claims 63-64

Claims 63-64 are rejected over the Tidwell patent in view of the Linnett patent and further in view of Batch et al.; U.S. Patent No. 5,423,023 (hereinafter "the Batch patent"). The Applicant traverses the arts grounds of rejection.

The Batch patent teaches a control routine which utilizes macros to control processes, including a sequence of tasks to interface between various tools. The Batch patent teaches the input data and control inputs are simply values or parameters used in the execution of already defined software tools. Specifically, the Batch patent requests "inputs when inputs to a software tool being executed are required" (col. 8, lines 40-46). Moreover, the Batch patent requests "items which the user must add as inputs ... [and inhibits] further operations of the tool ... until the user makes such required input" (col. 4, lines 61-64).

As previously explained, the Tidwell patent in view of the Linnett patent fails to teach, disclose or make obvious Applicant's claim 1, which is incorporated into Applicant's claim 64 and 65 (dependent from claim 1). Even a cursory review of the Batch patent reveals that the Batch patent does not overcome the disclosure and suggestion deficiencies of the Tidwell patent in view of the Linnett patent. Thus, for at least the reasons that the Applicant's claim 1 is allowable, claims 63-64 depend from allowable claim 1 and stand on their own merits, and because the deficiencies of the Tidwell patent in view of the Linnett patent are not resolved by the Batch patent, claims 63-65 are allowable. The Applicant respectfully requests that claims 63-64 be allowed.

CONCLUSION

Accordingly, in view of the above remarks, withdrawal of all outstanding rejections and allowance of each of the claims in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$110.00 extension fee herewith.

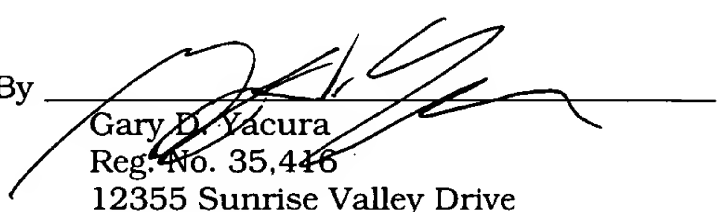
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Terance D. Madden, Reg. No. 51,207, at (703) 668-8024.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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